

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:	SCHERZER ET AL.	DOCKET NO.:	54166
SERIAL NO.:	10/784,815	CONFIRMATION NO.:	1166
FILING DATE:	02/24/2004	EXAMINER:	ZEMEL, IRINA SOPJIA
CUSTOMER NO.:	26474	ART UNIT:	1711

FOR:

Honorable Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Petition under 37 C.F.R. § 1.181

Statement of the facts involved: in response to the non-final office action of February 2, 2006, applicants filed a reply including amendments to the claims. In the subsequent office action of July 17, 2006, the examiner cited new prior art and inappropriately made the action final.

Point to be reviewed: whether the examiner erred in making the office action of July 17, 2006 final.

Action requested: withdraw the finality of the Office Action of July 17, 2006.

Remarks: “Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).”<sup>1</sup> The examiner asserts that “Applicant’s amendment necessitated the new ground(s) of rejection presented ...”<sup>2</sup> The amendments presented in response to the non-final office action are presented in Appendix I.

Claims 1, 2, 5, 24-27, 24-25 were rejected under 35 USC 102(b) as being anticipated by the newly cited reference, **Mitsubishi (JP 5-262910)**. This new ground of rejection is not necessitated by applicant’s amendment of the claims. For example, looking at claim 1, the examiner cites **Mitsubishi**, alleging that it “discloses completely open cell foams (up to 1005 [*sic*] open cell) composed of a high-temperature resistant thermoplastic

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<sup>1</sup> MPEP 706.07(a) Final Rejection, When Proper on Second Action.

<sup>2</sup> Page 5, lines 6-7, of the Office Action of July 17, 2006.

polysulfone polymer.”<sup>3</sup> The amendments to claim 1 did not necessitate this new ground of rejection. The amendment of claim 1 in response to the office action of February 2, 2006 was as follows:

1. (currently amended) A foam composed of a high-temperature-resistant thermoplastic selected from the group consisting of polyether sulfones, polysulfones, polyether ketones, polyether ether ketones, polyether ketone ketones, polyethersulfonamides, and mixtures of these, and having an open-cell structure, wherein the open-cell factor for the foam is at least 75%.

It should be clear that claim 1 prior to amendment disclosed “A foam composed of a high-temperature-resistant thermoplastic having an open-cell structure.” Thus, **Mitsubishi** could have been cited in the first office action and the new ground of rejection was not necessitated by the amendment.

For the sake of completeness and clarity it is noted that: all language added to claim 1 was part of claims 3 and 4 prior to the amendments as presented in response to the office action of February 2, 2006. Prior to their cancellation, claims 3 and 4 read as follows:

3. A foam as claimed in claim 1 or 2, wherein the open-cell factor for the foam is at least 75%, preferably at least 85%, particularly preferably at least 90%.
4. A foam as claimed in claim 1 or 2, wherein the high-temperature-resistant thermoplastic has been selected from the group consisting of polyetherimides, polyether sulfones, polysulfones, polyether ketones, polyether ether ketones, polyether ketone ketones, polyethersulfonamides, and mixtures of these.

Thus, the amendment to claim 1 necessitated no new ground for rejection whatsoever.

It is further respectfully submitted that MPEP §706.07(c) states that:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the

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<sup>3</sup> Page 2, lines 7-8, of the Office Action of July 17, 2006.

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Inventor: Scherzer

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same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection, and that ... in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. (emphasis added).<sup>4</sup>

The examiner has introduced a new ground of rejection that is not necessitated by applicant's amendment of the claims, and so the withdrawal of the finality of the Office Action of July 17, 2006 is requested.

Respectfully submitted,



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<sup>4</sup> MPEP §706.07(c).

APPENDIX I

Amendments to the claims presented in response to office action of February 2, 2006:

1. (currently amended) A foam composed of a high-temperature-resistant thermoplastic selected from the group consisting of polyether sulfones, polysulfones, polyether ketones, polyether ether ketones, polyether ketone ketones, polyethersulfonamides, and mixtures of these, and having an open-cell structure, wherein the open-cell factor for the foam is at least 75%.
2. (currently amended) A foam as claimed in claim 1, which has a cell size of from 50 to 2000  $\mu\text{m}$  ~~preferably from 100 to 1000  $\mu\text{m}$ , particularly preferably from 100 to 800  $\mu\text{m}$ , and/or has a density of from 20 to 200 g/l, preferably from 20 to 150 g/l, particularly preferably from 30 to 100 g/l.~~
3. (cancelled)
4. (cancelled)
5. (currently amended) A foam as claimed in claim 1, wherein the plastic has a glass transition temperature above 170°C, ~~preferably above 180°C, particularly preferably above 200°C, and/or is thermoplastically extrudable at temperatures above 280°C, preferably above 300°C, particularly preferably above 320°C.~~
6. (cancelled)
7. (cancelled).
8. (cancelled)
9. (cancelled)
10. (cancelled)
11. (cancelled)
12. (cancelled)
13. (cancelled)
14. (previously presented) A molding, in particular a sheet, comprising an open-cell foam as claimed in claim 1.
15. (cancelled).

16. (cancelled)
17. (cancelled).
18. (cancelled)
19. (cancelled)
20. (cancelled)
21. (cancelled)
22. (cancelled)
23. (cancelled)
24. (new) A foam as claimed in claim 1, wherein the open-cell factor for the foam is at least 85%.
25. (new) A foam as claimed in claim 1, wherein the open-cell factor for the foam is at least 90%.
26. (new) A foam as claimed in claim 1, which has a cell size of from 100 to 1000  $\mu\text{m}$ .
27. (new) A foam as claimed in claim 1, which has a cell size of from 100 to 800  $\mu\text{m}$ .
28. (new) A foam as claimed in claim 1, which has a density of from 20 to 200 g/l.
29. (new) A foam as claimed in claim 1, which has a density of from 20 to 150 g/l.
30. (new) A foam as claimed in claim 1, which has a density of from 30 to 100 g/l.
31. (new) A foam as claimed in claim 2, which has a density of from 20 to 200 g/l.
32. (new) A foam as claimed in claim 26, which has a density of from 20 to 150 g/l.
33. (new) A foam as claimed in claim 27, which has a density of from 30 to 100 g/l.
34. (new) A foam as claimed in claim 1, wherein the plastic has a glass transition temperature above 180°.
35. (new) A foam as claimed in claim 1, wherein the plastic has a glass transition temperature above 200°.

36. (new) A foam as claimed in claim 1, wherein the plastic is thermoplastically extrudable at temperatures above 280°.
37. (new) A foam as claimed in claim 1, wherein the plastic is thermoplastically extrudable at temperatures above 300°.
38. (new) A foam as claimed in claim 1, wherein the plastic is thermoplastically extrudable at temperatures above 320°.
39. (new) A foam as claimed in claim 5, wherein the plastic is thermoplastically extrudable at temperatures above 280°.
40. (new) A foam as claimed in claim 34, wherein the plastic is thermoplastically extrudable at temperatures above 300°.
41. (new) A foam as claimed in claim 35, wherein the plastic is thermoplastically extrudable at temperatures above 320°.